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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEWART E. SLOAN

Appeal 2007-4067
Application 10/827,032
Technology Center 3700

Decided: February 20, 2008

Before DONALD E. ADAMS, ERIC GRIMES, and LORA M. GREEN,
Administrative Patent Judges.

GRIMES, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a massage device. The Examiner has rejected the claims as anticipated, obvious, and lacking adequate written description in the Specification. We have jurisdiction under 35 U.S.C. § 6(b). We reverse the written description rejection but affirm the prior art rejections.

BACKGROUND

“Many times a person will experience a muscle spasm or back pain but is unable to reach the area of pain to massage the same” (Specification 1). The Specification discloses a massage device “comprising an elongated flexible handle having first and second ends with a resilient ball secured to the second end of the handle,” wherein the “ball is secured to the ... handle in such a way that permits the ball to move with respect to the handle” (*id.*). The Specification also discloses that

[w]hen a person experiences back or shoulder pain, the person grasps the handle and maneuvers the same to position the ball adjacent the area of pain. The person then leans back against the ball so that the ball is positioned between the person’s back and the back of a chair or the like. The person then moves with respect to the chair back so that the ball will roll over the area of back pain thereby massaging the same.

(*Id.* at 1-2.)

DISCUSSION

1. CLAIMS

Claims 2-15 are pending and on appeal. The claims subject to each rejection have not been argued separately and therefore stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii).

Claims 15, 2, 9, 11, and 12 are representative and read as follows:

Claim 15. In combination:

a massage device for enabling a person sitting in a high back chair to massage his/her back comprising
an elongated handle having first and second ends and
a ball secured to said second end of said handle
whereby said device may be moved into a position so that said ball is positioned between the person and the high back chair to enable the person to move relative to said high backed chair so that the person is able to move

with respect to the ball thereby creating a massaging effect to a portion of the person's body.

Claim 2. The combination of claim 15 wherein said handle is flexible.

Claim 9. The combination of claim 15 wherein said ball is resilient and is secured to said second end of said handle by a net material extending around said ball.

Claim 11. The combination of claim 15 wherein said first end of said handle has a hand-gripping portion thereon wherein said hand-gripping portion is generally V-shaped.

Claim 12. The combination of claim 15 wherein said handle is generally flat.

2. WRITTEN DESCRIPTION

Claims 2-15 stand rejected under 35 U.S.C. § 112, first paragraph, on the basis that they lack adequate written description in the Specification.

The Examiner finds that the claims contain subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention because the Specification does not provide antecedent basis for a V-shaped handle (Answer 3). We note that while the Examiner applied this ground of rejection to all of claims 2-15, only claim 11 recites the disputed limitation. We therefore reverse the rejection as applied to claims 2-10 and 12-15.

Appellant argues that originally filed claim 11 “described that the hand-gripping portion is generally V-shaped” and that “original claims form a part of the specification” (App. Br. 5-6).

The purpose of the written description requirement is to “ensure that the scope of the right to exclude, as set forth in the claims does not overreach the scope of the inventor’s contribution to the field of art as described in the patent specification.” *Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1345 (Fed. Cir. 2000). To that end, to satisfy the written description requirement, the inventor must “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). “One shows that one is ‘in possession’ of the invention by describing the invention, with all its claimed limitations”. *Lockwood v. American Airlines*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

We agree with Appellant that originally filed claim 11 provides adequate descriptive support for the disputed limitation. Claim 11 is an original claim and states that “the hand-gripping portion is generally V-shaped.” Figures 1 and 2 of the Specification also show a hand-gripping portion that is generally V-shaped.

Original claims are part of the specification of a patent application. *See Hyatt v. Boone*, 146 F.3d 1348, 1352 (Fed. Cir. 1998) (“The claims as filed are part of the specification, and may provide or contribute to compliance under § 112.”). Given the recitation of “a hand-gripping portion that is generally V-shaped” in originally filed claim 11, and the depiction in Figures 1 and 2 of a V-shaped hand-gripping portion, we conclude that the written description of the invention, as originally filed, conveys to those of skill in the art that the inventor was in possession of the claimed invention at the time the application was filed.

The rejection of claims 2-15 under 35 U.S.C. § 112, first paragraph, on the basis of lack a written description in the Specification is reversed.

3. ANTICIPATION

Claims 3, 4, 6, 8, 11, and 15 stand rejected under 35 U.S.C. § 102(b) as anticipated by Haygood.¹ The Examiner finds that “Haygood discloses ... a batting practice device that anticipates a combination massage device” comprising an elongated handle (Final Rej. 3-4).

We agree with the Examiner that Haygood discloses all of the limitations of claim 15. The massage device defined by claim 15 has two components: a handle having two ends, and a ball secured to one end (the “second end”) of the handle. Appellant does not dispute that Haygood’s device includes these features.

Claim 15 also requires that the handle is elongated. The Examiner finds that the Haygood device meets this limitation because Haygood’s device includes two elements (designated 4 and 12 in Haygood’s drawings) that hold the ball in place, and “the portion (4) of the handle is elongated. However, the other portion of the handle (12) extends the handle (which was interpreted as elongating the handle)” (Answer 4-5).

Appellant argues that “the oval-shaped handle 4 of Haywood is not elongated” (App. Br. 7).

We do not find this argument to be persuasive. It is well settled that “claims in an application are to be given their broadest reasonable interpretation consistent with the specification and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir.

¹ Haygood et al., US 5,597,159, Jan. 28, 1997.

1983) (citation omitted). In the instant case, the Specification does not define the phrase “elongated handle” as being only in one part, but provides only that the handle is elongated and flexible and is preferably made of plastic (Specification 3). Therefore, we interpret the phrase to mean that the elongated handle may be in two parts.

Haygood discloses a batting practice device having a handle, a hollowed-out practice ball, and a rope between the ball and the handle. (Haygood, Figure 1 and col. 3, ll. 29-31.) The broadest reasonable interpretation of “elongated handle” includes the portion of Haygood’s device made up of the oval-shaped handle and the rope attached to the ball. Therefore, claim 1 reads on the batting practice device disclosed in Haygood.

“Absent claim language carrying a narrow meaning, the PTO should only limit the claim based on the specification or prosecution history when those sources expressly disclaim the broader definition.” *In re Bigio*, 381 F.3d 1320, 1325 (Fed Cir. 2004). Thus, it would be improper to limit claim 1 only to the one-piece handle exemplified in the instant Specification. Because claim 1 does not have any language that distinguishes the claimed massage device from the batting practice device disclosed in Haygood, we agree with the Examiner that claim 15 encompasses the device disclosed in Haygood.

4. OBVIOUSNESS I

Claims 2 and 5 stand rejected under 35 U.S.C. § 103 as obvious in view of Haygood and Mitchell.² The Examiner relies on Haygood for the disclosure set forth above, but finds that “Haygood does not disclose the

² Mitchell, US 4,867,451, Sept. 19, 1989

handle being flexible” (Office action mailed Aug. 23, 2005 (“Final Rej.”) 3). The Examiner relies on Mitchell as disclosing “a flexible handle ... having a resilient ball ... attached at one end” (*id.*). The Examiner concludes that it “would have been obvious to one having ordinary skill in the art at the time that the invention was made that the handle disclosed by Haygood could be completely flexible as taught by Mitchell in order to allow the handle to wrap around the user’s hand” (*id.*).

We conclude that the Examiner has set forth a *prima facie* case that claim 2 would have been obvious to the ordinary artisan. Haygood is discussed above. Haygood also discloses that “the batting practice device has a combination of universal joints, elastic material, and springs located between the handle and the practice ball to help absorb most of energy transferred to the practice ball after it has been hit” (Haygood, abstract). Mitchell discloses “a toy comprising a soft and flexible ball and a handle in the configuration of a loop”, wherein “the loop is soft and flexible” (Mitchell, abstract).

We agree with the Examiner that it would have been *prima facie* obvious to one of skill in the art at the time the invention was made to combine the teachings of Haygood and Mitchell and thereby arrive at the invention of claim 2. Haygood teaches that flexibility in the batting practice device is required to absorb energy. Mitchell teaches a play device having a flexible handle. One of skill in the art would have understood that combining a flexible handle as taught by Mitchell with the device of Haygood would impart desired flexibility.

Appellant argues that “Mitchell is non-analogous art and that it relates to a toy while Appellant's invention relates to a massage device” and that a “person working in the massage device field would not look to the non-analogous toy art disclosed in the Mitchell patent” (App. Br. 7). Appellant also argues that “there is no suggestion or motivation ... to modify the prior art as the Examiner has proposed” (*id.* at 10).

We do not find these arguments to be persuasive. The question, with respect to § 103, is whether a person of ordinary skill in the art would have considered it obvious, based on the cited references, to modify the prior art devices in such a way as to create a device within the scope of the claims. Thus, in determining whether the references are from nonanalogous arts, the question is whether the inventions disclosed by Haygood and Mitchell are in the same field of endeavor or reasonably pertinent to a particular problem. *See In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992).

Haygood's disclosure relates to a device having a handle and a ball that is “used to swing a practice ball . . . in front of batters” (Haygood, abstract). Mitchell's disclosure relates to a device having a handle and a ball that can be used for, among other things, “tossing it back and forth” (Mitchell, col. 1, ll. 20-21). Since both references relate to devices that comprise a ball with a handle, and disclose that the devices are used in the same manner as handle-less balls (e.g., batting practice or playing catch), we agree with the Examiner that they are not from non-analogous arts.

As noted by the Supreme Court,

If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and

a person of ordinary skill would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1721, 1740 (2007). In other words, “familiar items may have obvious uses beyond their primary purposes.” *Id.* at 1742. We agree with the Examiner that one of skill in the art would look to the art of hand-held sporting devices having a handle attached directly or indirectly to a ball, generally, to find appropriate means to impart flexibility to the device.

5. OBVIOUSNESS II

Claims 7, 9 and 10 stand rejected under 35 U.S.C. § 103 as obvious in view of Haygood and Rodriguez.³ The Examiner relies on Haygood for the disclosure set forth above. The Examiner further finds that Haygood does not disclose “a net extending around the ball” and that Rodriguez discloses “a tennis volley practice device comprising a ball ... inside of a net ... wherein the net and the ball are attached to a handle” (Final Rej. 4). The Examiner concludes that it would have been obvious to use a net material, as taught by Rodriguez, to assist in holding the ball onto the handle (*id.*).

We conclude that the Examiner has set forth a *prima facie* case that claim 9 would have been obvious to the ordinary artisan. Haygood is discussed above. Rodriguez discloses a tennis teaching aid that includes a net that encloses a tennis ball and is tethered to the racquet by means of an elastic cord (Rodriguez, abstract, Figs. 1 and 2).

We agree with the Examiner that it would have been *prima facie* obvious to one of skill in the art at the time the invention was made to

³ Rodriguez, US 6,062,993, May 16, 2000.

combine the teachings of Haygood and Rodriguez; i.e., to attach the ball to the rope in Haygood's batting practice device by enclosing the ball in a net as taught by Rodriguez. The device made obvious by the combined references meets all the limitations of instant claim 9.

Appellant argues that claim 9 is "patentable for the reasons expressed in support of claim 15" (App. Br. 11). These arguments are addressed above.

Appellant further argues that the Haygood and Rodriguez prior art devices relate to non-analogous art in that the "Rodriguez device is a practice device used in the tennis field while Haygood relates to a batting practice device. It would have not been obvious to a person having ordinary skill in the massage device art to combine the teachings of Haygood and Rodriguez" (*id.*).

We are not persuaded by this argument. Haygood's disclosure relates to a device having a ball on a rope that is "used to swing a practice ball . . . in front of batters" (Haygood, abstract). Rodriguez's disclosure relates to a device having a ball on an elastic cord that is used "for practicing tennis strokes" (Rodriguez, col. 2, ll. 42-55). Since both references relate to devices that comprise a ball on a line, and disclose that the devices are used to practice hitting the ball (with a bat or racket), we agree with the Examiner that they are not from non-analogous arts.

6. OBVIOUSNESS III

Claims 12-14 stand rejected under 35 U.S.C. § 103 as obvious in view of Haygood, Mitchell and Killion.⁴ The Examiner relies on Haygood and Mitchell for the disclosures set forth above. The Examiner finds that

⁴ Killion, Des. 356,354, Mar. 14, 1995.

“Haygood does not disclose the handle being flat” but that “Killion teaches in figure 1 a handle that is flat” (Final Rej. 4). The Examiner concludes that it would have been obvious to one having ordinary skill in the art at the time that the invention was made to modify Haygood’s device to have a flat handle, as taught by Killion (*id.*).

We conclude that the Examiner has set forth a *prima facie* case that claim 12 would have been obvious to the ordinary artisan. Haygood and Mitchell are discussed above. Killion discloses a throw toy having a flat handle (Killion, claim and Fig. 1).

We agree with the Examiner that it would have been *prima facie* obvious to one of skill in the art at the time the invention was made to combine the teachings of Haygood, Mitchell, and Killion and thereby arrive at the device defined by claim 12. Claim 12 is directed to the device of claim 15, “wherein said handle is generally flat.” The Specification does not define the phrase “generally flat,” but illustrates an embodiment of the claimed device in Figure 1. The handle of Haygood’s device (see Haygood, Figs. 1 and 6) appears to be about the same thickness as the handle of the device depicted in Fig. 1 of the instant application. Thus, the device suggested by Haygood and Mitchell reasonably appears to have a “generally flat” handle, as required by claim 12. In any case, Killion also teaches a ball having a flat handle. We agree with the Examiner that the cited references would have made obvious the device of claim 12 to those of ordinary skill in the art.

Appellant argues that the “the connecting element of Killion is not substantially flat, as required by claim 12” and that “[e]ven if the three

references of record were combined, the resulting structure still would not correspond to Appellant's claimed structure" (App. Br. 11).

We are not persuaded by these arguments. For the reasons discussed above, when we give claim 12 its broadest reasonable interpretation consistent with the instant Specification, we conclude that it encompasses the handles taught by both Killion and Haygood.

Appellant further argues that even if the structure were obvious, "it would not be obvious to utilize the device as a massage device. There is absolutely no suggestion ... in the prior art that the devices ... relied upon by the Examiner could be used as a massage device for a person sitting in a high back chair" (App. Br. 12).

We are not persuaded by this argument. Claim 12 is a device claim and only requires that the device enable "a person sitting in a high back chair to massage his/her back." Claim language that merely recites an intended use does not limit the scope of the claims. *See, e.g., Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997).

SUMMARY

The Examiner's anticipation and obviousness rejections are supported by the preponderance of the evidence of record. We therefore affirm the rejection of claims 3, 4, 6, 8, 11 and 15 under 35 U.S.C. § 102 and the rejection of claims 2, 5, 7, 9, 10, and 12-14 under 35 U.S.C. § 103. However, we reverse the rejection of claims 2-15 under 35 U.S.C. § 112, first paragraph.

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Application 10/827,032

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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